

III. Remarks

The status of the claims is set forth in the above listing of the claims. Claims 1-24 remain pending in the present application. Applicant notes that claims 1-24 were rejected under 35 USC § 103(a) as being unpatentable over U.S. Patent No. 5,252,537 (“DeWinter-Scailteur”) and U.S. Patent No. 5,677,019 (“Carstairs et al.”).¹ Applicant respectfully disagrees with these rejections and respectfully requests reconsideration and allowance of all pending claims.

IV. Arguments

Independent claim 1 as originally submitted recites a “process to preserve natural flowers, characterized by a number of steps” including selecting and cutting the flowers, assembling supporting devices and grids, placing flowers in the grids, at least three dehydrating steps, an infiltration step, and an evaporation step. The Examiner states that *DeWinter-Scailteur* teaches a process for preserving natural flowers comprising a grid for receiving flowers, a dehydration step, and an infiltration step. The Examiner acknowledges that *DeWinter-Scailteur* does not teach a dehydration step comprising alcohol. The Examiner states that *Carstairs et al.* teaches a process for preserving cut flowers using alcohol and that it would have been obvious to one having ordinary skill in the art to modify the invention of *DeWinter-Scailteur* to include alcohol taught by *Carstairs et al.*²

Applicant asserts that the Examiner still failed to make out a *prima facie* case for a rejection under 35 U.S.C. § 103(a) because the Examiner did not find a reference for each element of independent claim 1, including selecting and cutting the flowers, at least three dehydration steps, and the evaporation step.

With respect to the selecting and cutting the flowers element, the Examiner asserts that “for the instant process it is inherent that an artisan would have to select and cut flowers in order to practice the process.” Applicant respectfully disagrees and submits that the *DeWinter-Scailteur* process may include cutting the flowers *after* the dehydration and infiltration steps are

¹ See *Office Action*, Page 2-4.

² *Id.*

complete. Under the MPEP, to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result given a set of circumstances is not sufficient. MPEP § 2112 (IV). The missing elements are not necessarily present in the *DeWinter-Scailleur* reference and, thus, the Examiner has not established inherency in the missing elements.

With respect to the three dehydration steps, the Examiner asserts that the *DeWinter-Scailleur* reference teaches “more than one drying or dehydration step.” Examiner notes that *DeWinter-Scailleur* suggests that “colorless flowers can be obtained with only two dehydration steps as opposed to three dehydration steps recited in the instant claims.” Thus, even if *DeWinter-Scailleur* teaches that two dehydration steps are sufficient, the reference also teaches away from using more than two dehydration steps. The Examiner cites column 2, lines 7-12 and column 3, lines 21-29 and asserts that *DeWinter-Scailleur* teaches at least two dehydration steps. Both of these citations actually support that *DeWinter-Scailleur* teaches a single dehydration step. Specifically, column 2 lines 7-12 discuss that the *DeWinter-Scailleur* “invention is distinguished in that it comprises a dehydration stage ensuring a perfect structural maintenance of the tissues” and column 3 lines 21-29 discuss draining the solvent after the above mentioned dehydration stage.³ Thus, *DeWinter-Scailleur* teaches only one dehydration stage, and not three consecutive dehydration stages as taught by claim 1. Even assuming *arguendo* the Examiner was correct that *DeWinter-Scailleur* teaches two dehydrations stages, the Examiner still failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 because claim 1 teaches three consecutive dehydration stages. As discussed in the previous response to the Non-Final Office Action dated March 18, 2009, three consecutive dehydrations, as opposed to a one-step

³ See, *DeWinter-Scailleur*, 2:7-12, 3:21-29.

dehydration process, provide several advantages including, but not limited to, the complete removal of the natural flower pigments and optimal solvent usage.

Also with respect to the three dehydration steps, *DeWinter-Scailteur* discusses dehydration using a molecular sieve. Specifically, *DeWinter-Scailteur* teaches the following:

The receptacle is closed hermetically and the solvents are left to act for at least 12 hours in the case of flowers of small volume, with relatively loosely packed petals, and up to 24 hours in the case of flowers with dense and closely packed petals. At the end of the dehydration, when the flowers have become completely transparent and colorless, the grid containing the flowers is taken out and solvents are allowed to drain out in order then to transfer the grid with the flowers to a new receptacle for the infiltration stage.⁴

In other words, the receptacle is filled with solvents and there is no removal of the solvents for completing various dehydration steps. This is in contrast to Claim 1, which teaches that the reactor is filed three times with solvent (of different alcohol percentages) and the solvent is removed three times. Claim 1 does not teach a molecular sieve, as taught by *DeWinter-Scailteur*, but instead teaches a normal distillation of solvents.

With respect to the evaporation step, the Examiner still has not directed the applicants to any specific portions of either the *DeWinter-Scailteur* or *Carstairs* references related to evaporation.

Applicant also asserts that the Examiner failed to make out a *prima facie* case for a rejection under 35 U.S.C. § 103(a) because even if the *DeWinter-Scailteur* and *Carstairs* references contained each and every element of claim 1, there is no motivation to combine the two references.

Applicant asserts that a person having ordinary skill in the art would not have been motivated to combine *Carstairs* with *DeWinter-Scailteur* due to the fact that *Carstairs* does not include a dehydration step. Specifically, the purpose of *Carstairs* is to obtain a preserved plant material by immersing the material in an aqueous solution that comprises C3-C6 dyhidric

⁴ See, *DeWinter-Scailteur*, 3:15-25.

alcohols and, more preferably, from 1% to 20% of C1-C5 monohydric alcohols.⁵ In other words, *Carstairs* teaches a process containing only one step and does not even mention dehydration. *Carstairs* does mention the use of alcohol in the “aqueous solution” but the use of this solution corresponds to an aspect of the invention not related to the purpose of alcohol in the present application (dehydration).⁶ Also, the ranges *Carstairs* teaches for the alcohol in the aqueous solution are 1% to 20% as compared to the ranges used in the present application (no less than 70% for any of the three dehydration steps).⁷ Finally, *Carstairs* teaches preserving flowers’ natural colors and, thus, a person having ordinary skill in the art would not be motivated to use the alcohol as it is taught in *Carstairs* for the purpose of the present invention, which includes using alcohol for dehydration and removal of the color of the flowers; and infiltration or coloring the flowers with a different color.

Dependent claims 2-24 depend from independent claim 1. Since these claims further limit a patentably distinct independent claim, the dependent claims are allowable on that basis as well as based on the additional patentably distinct limitations that they provide.

⁵ See, e.g., *Carstairs et al.*, 3:45-54 and claims 7-9.

⁶ *Id.*

⁷ *Id.*

V. **Conclusion**

In view of the foregoing amendments and remarks, it is respectfully submitted that this application is in condition for allowance. If any additional fees are required to complete this filing, or if an overpayment has occurred, the Commissioner is authorized to charge or credit such amount to Deposit Account No. 13-0480, referencing Attorney Docket No. 09163000.110000. The Examiner is cordially invited to contact the undersigned Attorney of Record if such would expedite the prosecution of this Application.

Respectfully submitted,

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Date: June 18, 2009

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